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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,064	01/20/2004	Ulrich Sander	33997.0095	2009
26712 7590 10/18/2007 HODGSON RUSS LLP THE GUARANTY BUILDING 140 PEARL STREET SUITE 100 BUFFALO, NY 14202-4040			EXAMINER HARRINGTON, ALICIA M	
			ART UNIT 2873	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,064

Applicant(s)

SANDER, ULRICH

Examiner

Alicia M. Harrington

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 16-19, 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8/6/07 have been fully considered but they are not persuasive. Applicant argues Su (US 6,685,317) fails to disclose the camera beam path separated from the observation beam path by the beam splitter. The embodiment of figure 4 teaches this feature.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Stuttler (US 5,907,431).

Regarding claim 1, Stuttler discloses microscope comprising a surgical microscope (18b), beam splitter (10C) and retinal diagnostic (7b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4-7,9,10,12-15,20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Su et al (US 6,685,317).

Regarding claim 1, Su discloses a surgical microscope system for observing an eye of a patient, the surgical microscope system comprising:

- A surgical microscope (35,36,7);

- A beam splitter (32 or 15a);

- A retinal diagnostic device (via 15,16,17,50,19-24,18)-see col. 7 and col. 8. See also the embodiment of figure 4, where the beam splitter 15a will allow imaging and viewing to occur at the same time (see col.10, lines 30-45)

Regarding claim 2, retinal lens (12 or 13)

Regarding claim 4, see figure 2 or 4.

Regarding claim 5, see col. 7, lines 14-35 or col. 10.

Regarding claim 6, output at element 3-figure 1.

Regarding claim 7, see figure 3 -#28.

Regarding claim 9, 21,22-see figure 2-col. 7, lines 20-42 or figure 4- col. 10.

Regarding claim 10, 28,41-col. 8, lines 25-55.

Regarding claim 12, see figure 2;col. 7, lines 1-10.

Regarding claim 13, objective -7, retinal -13; col. 7, lines 10-25.

Regarding claim 14, see col. 7, lines 10-25.

Regarding claim 15, see col. 9, lines 1-5.

Regarding claim 20, see col. 7, lines 20-30.

Regarding claim 21, see col. 9, lines 1-9; the sensor processor (computer) command trigger signal.

Regarding claim 22, see col. 8, lines 35-52.

Regarding claim 23, a surgical microscope (35,36,7)-see figures 2a, 2; a beam splitter (32); a retinal diagnostic (via 15, 16, 17, 50, 19-24, 18); microscope illumination (35,36); first light guide (28); an illumination source (42-see figure 3)-see col. 7- switching between retinal imaging and observation or the embodiment of figure 4 where the beam splitter 15a will allow imaging and viewing to occur at the same time (see col. 10, lines 30-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al.

Regarding claim 3, Su fails to specifically disclose the retinal lens contacts the patient's eye. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a retinal/object lens in contact with eye, since this is a known diagnostic method.

Regarding claim 8, Su discloses the illumination being a high-speed illumination source. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stroboscopic light source because it would be an equivalent high-speed illuminations source and are readily available for imaging units.

Regarding claim 11, Su fails to specifically disclose a diffractive element and lens for in the imaging system. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a diffractive element for aid in correction of chromatic aberration since diffractive elements are typically used in optical system for this purpose.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitajami (US 5,865,829).

Regarding claims 1-2, Kitajami discloses surgical microscope (see figure 1 and 8) and col. 5, lines 35-67 and col. 6, lines 1-40 and col. 9. However, Kitajami failed to specifically disclose a digital camera. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include this feature since digital imaging contains less noise.

Allowable Subject Matter

10. Claim 27-28 is allowed.

11. Claims 16-19, 24-26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 27, prior art fails to specifically disclose a surgical microscope system for observing the eye of a patient, the surgical microscope system comprising a surgical microscope, beam splitter, retinal diagnostic having a digital camera, camera beam path from the beam splitter, further comprising a beam transposer removably installed in the observation beam path between the stereo tube and beam splitter as claimed.

Regarding claim 16, prior art fails to specifically disclose a surgical microscope system for observing the eye of a patient, the surgical microscope system comprising a surgical microscope, beam splitter, retinal diagnostic having a digital camera, camera beam path from the beam splitter, retinal lens movable into and out of the observation beam path; a main objective and further comprising a beam transposer movable into and out of the observation path at a location between the main objective and patient's eye as claimed.

Regarding claim 24, prior art fails to specifically disclose a surgical microscope system for observing the eye of a patient, the surgical microscope system comprising a surgical microscope, beam splitter, retinal diagnostic having a digital camera, camera beam path from the beam splitter, a microscope illumination system, a first light guide, illumination source further comprising a second light guide arrange; and optical lighting branch switch connecting the first light guide and the second light guide to the illumination

source , whereby light from the illumination source can be switched between the first light guide for use in transscleral retinal illumination and the second light guide for use in microscope illumination as claimed.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Harrington whose telephone number is 571 272 2330. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571 272 2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Alicia M Harrington
Primary Examiner
Art Unit 2873

AMH